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EXAMINER

TRAN, H

ART UNIT

PAPER NUMBER

1764

DATE MAILED:

11/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/135,804**

Applicant(s)  
**Marocco**

Examiner  
**Hien Tran**

Group Art Unit  
**1764**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Specification*

1. The use of the trademark "Dow-Corning XT" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The disclosure is objected to because of the following informalities:

On page 19, line 5 --or embodiment or device-- should be inserted before "10" for consistency (note page 23, line 6).

On page 20, line 10 --element or pipe element-- should be inserted before "34" for consistency (note lines 11-12, 15, 17).

On page 21, line 13 "portion" should be changed to --pipe element--; in line 19 --or sound attenuating plenum-- should be inserted before "44" (note page 19, line 26).

On page 23, line 16 "embodiment" should be changed to --rearward portion-- (note page 22, line 23); in line 19 --or device or-- should be inserted before "embodiment" (note page 23, line 5, page 22, line 19).

On page 24, line 6 --or rearward end or outlet end-- should be inserted before "78" (note page 24, line 13, page 23, lines 17-18); in line 8 --or section-- should be inserted before "70".

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On page 25, lines 2 and 9 --portion-- should be inserted before "84". See page 27, line 2 likewise).

On page 26, line 15 --or toroidal front plate-- should be inserted before "82"; in lines 8 ad 10 "end" should be changed to --section--; in line 9 "end" should be changed to --portion--; in line 12 --portion-- should be inserted before "84"; in line 13 "rearward element" should be changed to --conical section--; in line 22 "70" should be changed to --68--.

On page 27, line 2 "end" should be changed to --section--; in line 3 --rearward-- should be inserted before "end"; in line 18 "volume" should be deleted.

On page 28, line 5 --catalytic converter-- should be inserted after "single"; in line 9 --combination-- should be inserted before "100".

On page 30, line 2 --or forward toroidal plate-- should be inserted before "132"; in line 6 --or rearward toroidal plate-- should be inserted before "134".

On page 31, line 24 "shell" should be deleted.

On page 36, line 19 "portion" should be deleted.

Note that applicant should use the same terminology throughout the specification and claims to avoid confusion.

Appropriate correction is required.

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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***Claim Rejections - 35 USC § 112***

4. Claims 1-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3 “the exhaust system” lacks positive antecedent basis; in line 23 “low” is a relative term and therefore is vague and indefinite. See claims 11, 21 likewise.

In claim 7, it is unclear as to what is intended by “width”. See claims 17, 27 likewise.

In claim 8, line 3 “thin” and “large” are relative terms and therefore are vague and indefinite. See claims 18, 28 likewise.

Claims 9, 19, 29 contain the trademark/trade name “Dow-Corning XT”. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. § 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark or trade name is used to identify or describe the ceramic material and accordingly the identification/description is indefinite.

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In claim 11, lines 6-7 it is unclear as to what is intended by "rearward inner thickness" (see claim 21 likewise); in lines 15-16 it is unclear as to what is intended by "outer width", it appears that applicant is attempting to define the diameter of the canister and the resonator element; in line 25 it is unclear as to what is intended by "axially parallel to one another" and where such is shown in the drawings.

In claim 12, it is unclear as to what applicant is attempting to recite, apparently "at least said forward portion and said rearward portion of" in lines 2-3 should be deleted.

In claim 21, lines 19-20 it is unclear as to what is intended by "said outer diameter ... being smaller than said rearward inner thickness ..."; in line 33 "desired" is vague and indefinite and should be deleted.

In claim 24, line 2 "said forward end" lacks positive antecedent basis and it is unclear as to whether it is the same as to the forward portion set forth in claim 21, line 15. See claim 30 likewise.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4, 6, 9, 21, 24-26, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner et al (5,355,973).

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Wagner et al disclose an apparatus for modifying an exhaust stream comprising:

a canister 11 including an inlet end 17, a forward portion, a rearward portion and an outlet end 18, a forward inner diameter and a rearward inner diameter;

at least one catalytic converter element 50 installed within the forward portion of the canister 11, said catalytic converter element 50 having an outer diameter and including a substrate 51 having a plurality of passages defined by plurality of walls;

a resonator element 65 installed within the rearward portion of the canister 11, said resonator element 65 having a hollow core, a forward end, a rearward end, an outer diameter, and a plurality of sound attenuating perforations 84 formed radially therethrough;

said outer diameter of the resonator element 65 being smaller than the rearward inner diameter of the canister 11 and defining a sound attenuating plenum 85 therebetween; and

said inlet end 17 of the canister 11, said plurality of passages of the catalytic converter element 50, said hollow core of said resonator element 65 and said outlet end 18 of said canister 11 all being axially aligned with one another.

With respect to claim 2, the canister 11 of Wagner et al is a tubular shell.

With respect to claims 4, and 24, refer to the plates 66 and 77 in Wagner et al.

With respect to claims 6, and 26, refer to the catalytic converter element 50 (Fig. 3) of Wagner et al.

With respect to claims 9, and 29, Wagner et al disclose that the catalytic converter element 50 is made of ceramic material (col. 9, lines 5-15).

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With respect to claim 21, Wagner et al disclose that the rearward end of the resonator element 65 extends outwardly beyond said outlet end 18 of the canister 11.

With respect to claim 25, the plate 66 of Wagner et al does not have passages therethrough.

Instant claims 1-2, 4, 6, 9, 21, 24-26, 29 structurally read on the apparatus of Wagner et al.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

9. The art area applicable to the instant invention is that of catalytic converter.

One of ordinary skill in this art is considered to have at least a B.S. degree, with additional education in the field and at least 5 years practical experience working in the art; is aware of the state of the art as shown by the references of record, to include those cited by applicants and the examiner



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(*ESSO Research & Engineering V Kahn & Co*, 183 USPQ 582 1974) and who is presumed to know something about the art apart from what references alone teach (*In re Bode*, 193 USPQ 12, (16) CCPA 1977); and who is motivated by economics to depart from the prior art to reduce costs consistent with the desired product characteristics. *In re Clinton* 188 USPQ 365, 367 (CCPA 1976) and *In re Thompson* 192 USPQ 275, 277 (CCPA 1976).

10. Claims 3, 22-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over as applied to claims above, and further in view of Munro (4,541,240). <sup>wagner et al</sup>

With respect to claims 3 and 23, the modified apparatus of <sup>wagner et al</sup> is substantially the same as that instantly claimed, but is silent as to the specific material for the canister and the resonator element.

However, Munro discloses the conventionality of providing a canister and a resonator element made of steel. Munro also discloses that the sound absorbent material is disposed in the sound attenuating plenum between the canister and the resonator element.

It would have been obvious to one having ordinary skill in the art to select an appropriate material for the canister and the resonator element, such as steel as taught by Munro in the apparatus of Wagner et al on the basis of its suitability for the intended use as a matter of obvious design choice and since use of such is conventional in the art and no cause for patentability here.

With respect to claim 22, it would have been obvious to one having ordinary skill in the art to provide sound absorbent material in the sound attenuating plenum between the canister and the resonator element as taught by Munro in the apparatus of Wagner et al to absorb sound.

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11. Claims 5, 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (5,355,973) in view of Plemons, Jr. (5,183,976).

Plemons, Jr. discloses provision of a forward plate 22 with a solid periphery devoid of passages and a rearward plate 24 with a plurality of passages 34.

It would have been obvious to one having ordinary skill in the art to construct the forward and rearward plates as taught by Plemons, Jr. in the apparatus of Wagner et al so as to allow the exhaust gas exiting the resonator plenum.

12. Claims 7-8, 27-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (5,355,973) in view of either Berg et al (4,364,761) or Lachman et al (3,885,977).

The apparatus of Wagner et al is substantially the same as that of the instant claims, but is silent as to the specific width of the passages of the catalytic converter element.

Berg et al and Lachman et al disclose provision of a ceramic substrate having passages wherein the width of each passage is greater than 0.040 inch (see col. 3, lines 4-6 in Berg et al and col. 16, line 7 in Lachman et al).

It would have been obvious to one having ordinary skill in the art to select the specific width as taught by Berg et al or Lachman et al in the apparatus of Wagner et al for reducing restriction to the exhaust gas flow and since such is conventional in the art and no cause for patentability here. .

With respect to claims 8 and 28, the passages of the substrate in Berg et al or Lachman et al appear to have a large width which falls within the instant range and the walls of the substrate appear to be thin.

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13. Claims 10, 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (5,355,973) in view of Ignoffo (4,032,310) or Harris (5,016,438).

Ignoffo and Harris show the conventionality of providing more than one catalytic converter elements.

It would have been obvious to one having ordinary skill in the art to provide more than one catalytic converter element in the apparatus of Wagner et al as taught by Ignoffo and Harris for further purifying exhaust gas.

14. Claims 11-12, 14, 16, 19-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (5,355,973) in view of JP 64-12017 and Harris (5,016,438).

The apparatus of Wagner et al is substantially the same as that of the instant claims, but fails to disclose whether the inlet and outlet ends may be provided in pair and whether more than one resonator element may be provided.

However, JP 64-12017 discloses provision of inlet and outlet ends provided in pair.

Harris discloses the conventionality of providing more than one resonator elements 80.

It would have been obvious to one having ordinary skill in the art to alternatively provide more one inlet and outlet ends, as taught by JP 64-12017 and provide more than one resonator element as taught by Harris in the apparatus of Wagner et al on the basis of its suitability for the intended use as a matter of obvious design choice and since use of such is conventional in the art and no cause for patentability here and since it has been held that mere duplication of the essential

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working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to claim 12, the canister 11 of Wagner et al is a tubular shell.

With respect to claim 14, refer to the plates 66 and 77 in Wagner et al.

With respect to claim 16, refer to the catalytic converter element 50 (Fig. 3) of Wagner et al.

With respect to claim 19, Wagner et al disclose that the catalytic converter element 50 is made of ceramic material (col. 9, lines 5-15).

With respect to claim 20, the same comments regarding more than one catalytic converter elements with respect to Harris apply.

15. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (5,355,973) in view of JP 64-12017 and Harris (5,016,438) as applied to claims 11-12, 14, 16, 19-20 above, and further in view of Munro (4,541,240).

The same comments with respect to Munro apply.

16. Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (5,355,973) in view of JP 64-12017 and Harris (5,016,438) as applied to claims 11-12, 14, 16, 19-20 above, and further in view of Plemons, Jr. (5,183,976).

The same comments with respect to Plemons, Jr. apply.

17. Claims 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (5,355,973) in view of JP 64-12017 and Harris (5,016,438) as applied to claims 11-12, 14, 16, 19-20 above and further in view of either Berg et al (4,364,761) or Lachman et al (3,885,977).

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The same comments with respect to Berg et al and Lachman et al apply.

***Conclusion***

18. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1764.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (703) 308-4253. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode, can be reached on (703) 308-4311. The fax phone number for this Group is (703) 305-3599 (for Official papers after Final), (703) 305-5408 (for other Official papers) and (703) 305-6078 (for Unofficial papers).

When filing a FAX in Group 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

HT  
November 11, 1999

*Hien Tran*

**HIEN TRAN  
PRIMARY EXAMINER  
GROUP 1700**